

REMARKS

This responds to the Office Action mailed on June 17, 2005.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1-20 are pending in this application.

§101 Rejection of the Claims

Claims 9-11 and 15-20 were rejected under 35 USC § 101. Specifically, the Office Action stated that the claimed invention is not limited to tangible embodiments. The Applicant respectfully traverses this rejection.

The Federal Circuit has stated that the claimed invention as a whole must accomplish a practical application. That is, it must produce a useful, concrete, and tangible result.¹ The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research.² Consequently, a tangible result under the patent law is not limited in a physical sense, but limited in the sense that the invention has some real world value. *See e.g., State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601 (the calculation of a final share price constitutes a practical application of a formula because it produces a useful, concrete, and tangible result---a final share price momentarily fixed for recording and reporting purposes).

The Patent Office has the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when a claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 USC § 101.³ Consequently, when determining the eligibility of a claimed invention for patent protection under 35 USC §

¹ *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998).

² MPEP § 2106.

³ MPEP § 2106.

101, the claims must be considered as a whole.⁴ The subject matter that courts have found to be unpatentable subject matter is limited to abstract ideas, laws of nature, and natural phenomena.⁵

The invention recited in claim 15 produces a tangible result that has real world value. The signal-bearing medium of claim 15 includes a page, and the page includes an object, a client application to fetch a history of the status of that object, and a script application to detect the object and inform the client application of the object. The tangible result is that the client application is informed of the object. This is akin to a final share price that is momentarily fixed for recording and reporting purposes, and as such, is statutory subject matter. Moreover, that a client application is informed of the object and/or the status of the object is a real world application, especially in the world of Internet applications.

Similarly, claim 9 recites a signal-bearing medium bearing a page. The page includes an object, a client application to poll a server for the status of the object, and a script application to detect the object in a page, inform the client application of the object, and display the status of the object. Therefore, like claim 15, claim 9 as a whole recites an invention that produces a tangible result and therefore has real world value.

Consequently, claims 9 and 15, when considered as a whole as the Patent Office is required to do, recite patentable subject matter, and the Applicant respectfully requests the withdrawal of the rejection of claims 9 and 15 under 35 USC § 101. Since claims 10 and 11 depend on and contain all the limitations of claim 9, and claims 16-20 depend on and claim all of the limitations of claim 15, the Applicant further submits that these dependent claims recite patentable subject matter, and further respectfully requests the withdrawal of the rejection of these claims under 35 USC § 101.

Additionally, other tests for patentable subject matter used by the courts and the Patent Office illustrate that the inventions recited in claims 9 and 15 recite patentable subject matter.

The invention recited in claims 9 and 15 do not occur naturally and are the result of human intervention.⁶ It is beyond debate that a client application does not occur without human intervention, or that human intervention is required to inform such a client application of the status of an object. Similarly, a signal-bearing medium, including a wireless medium, does not

⁴ MPEP § 2106.

⁵ MPEP § 2106.

⁶ See MPEP § 2150, citing *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980).

include a page without human intervention. The specific electromagnetic radiation representing that page on the signal-bearing medium would not exist but for the intervention of a human, and that signal-bearing medium is used directly by a computer processor to invoke client applications and scripts. As such, claims 9 and 15 are not directed solely to an abstract idea, are not devoid of any limitation to a practical application in the technological arts, and are not one of the three subject matters (abstract ideas, laws of nature, natural phenomena) that courts have found to be unpatentable subject matter.

§102 Rejection of the Claims

Claims 9-11 were rejected under 35 USC § 102(e) as being anticipated by Todd et al. (U.S. 6,742,059).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), *cert. denied*, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (*emphasis added*). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131.

Claim 9 of the present application recites a signal-bearing medium bearing a page. The claim further recites that the medium includes an object, a client application to poll a server for the status of the object, and a script application that detects the object in the page, informs the client application of the object, and displays the status of the object.

Todd et al. relates to a system including multiple servers that interface with a client and a peripheral. The servers include software that determines the state of the peripheral, and allows

the client to determine the operating state of a single peripheral.⁷ Status requests may be submitted to the servers until each server has been polled and has provided its status to the client.⁸ Such a request may be a detailed primary request,⁹ or a less detailed secondary request.¹⁰ If a server has a failed connection to the peripheral, a primary request is generated for that peripheral.¹¹

Todd et al. does not anticipate claim 9 of the present application because Todd et al. does not disclose each and every limitation recited in claim 9. Claim 9 recites, *inter alia*, “a script application to detect the object in the page, inform the client application of the object, and display the status.” The portion of Todd et al. recited in the Office Action does not disclose a script that detects an object in a page, and further does not disclose displaying a status of the object. The referenced portion of Todd rather uses the status of a peripheral to determine if a more detailed request should be made to a particular server.¹² Claim 9 is therefore not anticipated by Todd et al. Since claims 10 and 11 are dependent on claim 9, claims 10 and 11 contain all the limitations of claim 9, and are therefore also not anticipated by Todd et al. The Applicant consequently respectfully requests the withdrawal of the rejection of claims 9-11.

Claims 15-20 were rejected under 35 USC § 102(e) as being anticipated by Devine et al. (U.S. 6,385,644) in view of Moeller et al. (U.S. 6,662,208).

The Applicant respectfully submits that the rejection of claims 15-20 under 35 USC § 102(e) is improper. To reject a claim under 102(e), a single reference must contain, either literally or implicitly, each and every limitation recited in the claim at issue. The Office Action itself states that Devine et al. does not explicitly disclose fetching a history of the status of an object. Therefore, Devine et al. cannot anticipate claims 15-20 under 102(e), and the Applicant respectfully requests the withdrawal of this rejection.

⁷ Todd, Abstract.

⁸ Todd, Col. 3, line 63 – Col. 4, line 3.

⁹ Todd, Col 3, lines 34-41.

¹⁰ Todd, Col. 3, lines 53-55.

¹¹ Todd, Col. 3, lines 3-9.

¹² Todd, Col 4, lines 5-9.

§103 Rejection of the Claims

Claims 1-8 were rejected under 35 USC § 103(a) as being unpatentable over Dillingham (U.S. 6,327,608) in view of Todd et al. (U.S. 6,742,059), and further in view of Smith et al. (U.S. 6,771,744).

The Patent Office bears the initial burden of factually supporting a *prima facie* case of obviousness.¹³ In order for the Office Action to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.¹⁴

Claim 1 recites a process that includes sending a request for an operation selected from a page to a server (wherein the page is displayed by a browser interpreting data and control information in the page), receiving a verification that the request for the operation was received, executing an application identified by the page to poll the server for a result of the operation, and receiving the result of the operation.

The Office Action has failed to establish a *prima facie* case of obviousness regarding claims 1-8. The Office Action relies on U.S. Patent No. 6,771,744 to Smith et al. However, the Applicant respectfully submits that Smith et al. is not prior art. The present application was filed on March 5, 2002. The application that led to the issuance of the '744 patent was not filed until March 21, 2002. Since the Office Action has not established a *prima facie* case of obviousness, the Applicants respectfully request the withdrawal of the rejection of claims 1-8 under 35 U.S.C. § 103(a).

¹³ MPEP 2142.

¹⁴ MPEP § 2142 (citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Claims 12-14 were rejected under 35 USC § 103(a) as being unpatentable over Dillingham (U.S. 6,327,608) and Robert (U.S. 6,295,551).

Claim 12 recites a server that includes a processor and a memory coupled to the processor. Claim 12 further recites that the memory includes a server application to 1) build a page including an object, control information, and an initial status of the object, 2) send the page to a client, 3) queue a change in the status, and 4) send the change to the client.

Dillingham relates to remote browsing and administration of physical file directories that are resident on a server from a remote client browser. The client browser sends an HTTP request including the path to the server, and a server side script enumerates the files in the path indicated in the client request. The server side script then creates a client side script that will present the file data to the client.¹⁵

Roberts et al. relate to a call center system that allows a user to jointly browse World Wide Web content while simultaneously conducting a voice conversation over either a circuit switched or a packet switched network.

The Applicant respectfully submits that the Office Action has failed to establish a *prima facie* case of obviousness. The cited references neither disclose all the elements of claim 12, nor supply a proper motivation to combine the references. The portions of Dillingham cited by the Office Action deal only with an exemplary computer system,¹⁶ and the process of inquiring about server side files from the client side.¹⁷ Moreover, the data returned to the client includes only file data such as the file name, last date modified, and file size.¹⁸ Dillingham does not disclose, *inter alia*, building a page comprising control information as required by claim 12.

Additionally, the portion of Roberts et al. cited by the Office Action relates to a queue of caller requests in a voice communication system. Claim 12 recites a queue that relates to a change in status of an object in a client server system. There is no teaching, suggestion or motivation to combine Dillingham and Roberts et al. which deal with separate and distinct technologies. Moreover, even if the references disclosed all the elements of claim 12, such a general motivating factor as relied upon in the Office Action fails to motivate one of skill in the

¹⁵ Dillingham, Abstract.

¹⁶ Dillingham, Col. 4, line 45 – Col. 5, line 40.

¹⁷ Dillingham, Col. 7, line 56 – Col. 8, line 13.

¹⁸ Dillingham, Col. 8, lines 1-3.

art to specifically combine Dillingham and Roberts et al. *See in re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002) (there must be objective evidence and specific factual findings with respect to the motivation to combine references). *See also, Ecolochem v. Southern California Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2002) (broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence of obviousness).

Consequently, the Applicant respectfully submits that claim 12 is not unpatentable over Dillingham and Roberts et al. under 35 U.S.C. § 103(a), and further respectfully submits that the rejection should be withdrawn. Moreover, since claims 13 and 14 are dependent on claim 12 and therefore contain the “control information” limitation of claim 12, claims 13 and 14 are also not unpatentable over Dillingham and Roberts et al., and the Applicant respectfully requests the withdrawal of the rejection of claims 13 and 14.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-371-2140) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

PAUL T. BLOOMQUIST ET AL.

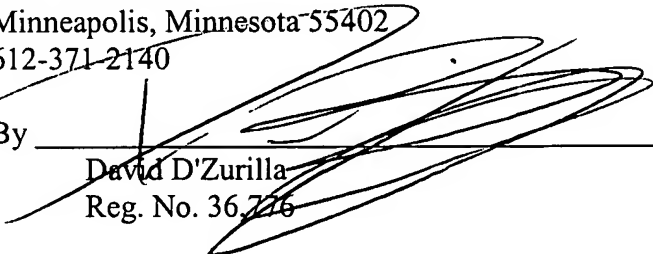
By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
Attorneys for Intel Corporation
P.O. Box 2938
Minneapolis, Minnesota 55402
612-371-2140

Date

September 19, 2005

By


David D'Zurilla
Reg. No. 36,776

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